

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

*In re* application of

DESJARLAIS et al.

Application No. 10/820,466

Filed: 03/31/2004

For: *Methods for Rational Pegylation of  
Proteins*

Examiner: LIN, Jerry

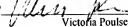
Art Unit: 1631

Conf. No.: 7266

**CERTIFICATE OF ELECTRONIC TRANSMISSION**  
**UNDER 37 C.F.R. 1.6(a)(4)**

I hereby certify that this correspondence, including listed enclosures, is being electronically transmitted in Portable Document Form (PDF) through EFS-Web via Hyper Text Transfer Protocol to the United States Patent and Trademark Office on:

Dated: October 2, 2007

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Victoria Poulsen

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT  
UNDER 37 CFR 1.181(a)**

**Mail Stop Petitions**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit a Petition to Withdraw Holding of Abandonment under 35 CFR 1.181(a). As provided by MPEP 711.03(c)(I), Applicants believe that no fee is due.

***Statement of Facts***

1. On July 1, 2005, Applicants filed a change of address associated with customer number 32940. The Request for Customer Number Data Change, enclosed herewith as Exhibit A, shows that at least as of July 1, 2005, Applicants were to receive all further correspondence at 555 California Street.

2. In July of 2005, Applicants filed a change of address with the United States Postal Service.

3. Roughly a year later, presumably sometime in July of 2006, the United States Postal Service discontinued the forwarding of mail to Applicants' new address at 555 California Street, in accordance with Postal Service procedures.

4. On September 13, 2006, the Office mailed a Requirement for Restriction/Election to Applicants' previous address at Four Embarcadero Center.

5. On September 25, 2006, the Office received the Requirement for Restriction/Election, which was returned to the Office as undeliverable.

6. On December 1, 2006, attorneys for Applicants moved to a new law firm.

7. On March 13, 2007, the six month statutory period for submitting a response to the Requirement for Restriction/Election lapsed. Applicants did not submit a response to the Requirement for Restriction/Election within this period.

8. On April 12, 2007, a Notice of Abandonment was mailed to Applicants' previous address at Four Embarcadero Center.

9. On April 20, 2007, the Office received the Notice of Abandonment, which was returned to the Office as undeliverable.

10. Applicants never received the Requirement for Restriction/Election mailed September 13, 2006.

11. All Office communications received by Applicants are docketed in Applicants' docketing system.

12. A search of the file jacket and docket records from September 13, 2006, (the date of mailing of the Requirement for Restriction/Election) to April 12, 2007, (the date of mailing of the Notice of Abandonment) indicates that the Requirement for Restriction/Election was not received.

13. Exhibit B enclosed herewith shows Applicants' docket record from September 13, 2006, to December 1, 2006 for the present application.

14. Exhibit C enclosed herewith shows Applicants' docket record from December 1, 2006 to April 12, 2007. Because of the change in law firms, Docket No. 34100/US/2 in Exhibit B corresponds to Docket No. 67461-5118 in Exhibit C. In Exhibit C, a query on Docket No. 67461-5118 would show docket entries for the present case, Application No. 10/820,466. Exhibit C indicates no docket entries during the period spanning December 1, 2006 to April 12, 2007.

15. Exhibit D enclosed herewith shows all of the docket entries for the present application. Entries with respect to the Requirement for Restriction/Election mailed September

13, 2006, were entered, as indicated, on April 19, 2007, which was *after* the date of mailing of the Notice of Abandonment on April 12, 2007.

**Non-receipt and non-docketing of the Requirement for Restriction/Election mailed September 13, 2006, is not in dispute.**

The file history clearly shows that Applicants did not receive the Requirement for Restriction/Election mailed September 13, 2006. The United States Postal Service returned to the Office both the original Requirement for Restriction/Election mailed September 13, 2006, and the original Notice of Abandonment as undeliverable. In addition, Applicants have attached docket records that indicate that those office communications were never received and docketed. Based on the return to the Office of the original office communications as undeliverable as well as the attached docket records, Applicants do not believe that further documentary evidence is necessary to prove non-receipt of the office communication to which reply was required to avoid abandonment. Applicants note that in light of the Office's efforts "to minimize costs and burdens to the practitioner and the Office" in situations such as this, the attached docket record should be deemed sufficient evidence for the present petition. See 1156 OG 53 (October 25, 1993).

**The Office has failed to follow proper procedure in notifying Applicants of actions taken by the Office.**

Because of the Office's failure to follow its own procedure for notification set forth in the Manual of Patent Examining Procedure as well as Title 37 of the Code of Federal Regulations, the instant application has been improperly held abandoned.

37 CFR 1.32(a)(5)(i) states that "*Customer Number* means a number that may be used to [d]esignate the correspondence address of a patent application or patent such that the correspondence address for the patent application, patent or other patent proceeding would be the address associated with the Customer Number[.]" The Office will direct all notices, official letters, and other communications relating to the application to the correspondence address. 37 CFR 1.33(a).

Where multiple addresses are associated with an application, the Office must select the address associated with a Customer Number. See 37 CFR 1.33(a) ("If more than one correspondence address is specified in a single document, the Office will select one of the specified addresses for use as the correspondence address and, if given, will select the address associated with a Customer Number over a typed correspondence address."). As the Office will not recognize more than one correspondence address, 37 CFR 1.33(a), any inconsistencies

between the correspondence address resulting from a Customer Number being provided in an application for the correspondence address and any other correspondence address provided in that application will generally be resolved in favor of the address of the Customer Number. MPEP 403(I).

The relocation of Applicants' Representatives resulted in the appearance of more than one correspondence address in the file wrapper of the instant application. The rules require that that such inconsistency be resolved in favor of the address of the Customer Number. The procedure for sending correspondence to the address associated with a Customer Number was not followed in the instant application, resulting in nonreceipt of a Requirement for Restriction/Election and a subsequent holding of abandonment. The Office's failure to adhere to the procedure provided in the Code of Federal Regulations and the Manual of Patent Examining Procedure has further resulted in a loss of potential patent term.

**Application No. 10/820,466 has not been abandoned and the holding of abandonment must be withdrawn.**

Although a Notice of Abandonment has been mailed for the instant application, Applicants contend that the application is not in fact abandoned.

35 USC 132(a) requires that "[w]henever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof[.]" Failure to prosecute the application within six months of the mailing of an office action results in the application being regarded as abandoned. 35 USC 133. However, the Office is compelled to withdraw the holding of abandonment and to remail any correspondence where Applicants have shown that they have not received the Office communication to which reply is required to avoid abandonment. *See Delgar, Inc. v. Schulyer*, 172 USPQ 513 (D.D.C. 1971); *see also* MPEP 711.03(c)(I).

To establish nonreceipt of an Office communication, the practitioner must state that the Office communication was not received by the practitioner and must attest to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. MPEP 711.03(c)(I)(A). A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. *Id.*

As stated above, the Requirement for Restriction/Election of September 13, 2006, was not received by Applicants. A search of the file jacket and docket records indicates that the Office

communication was not received. Applicants have enclosed a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed.  
*See Exhibits B, C & D.*

Having complied with requirements set forth in *Delgar* and MPEP 711.03(c), Applicants have satisfied the showing required to establish that the Requirement for Restriction/Election of September 13, 2006, was never received. Applicants therefore request that the Petition to Withdraw the Holding of Abandonment be granted and that the Office remain the outstanding Requirement for Restriction/Election.

In addition, the Applicants note that any patent issuing from Application No. 10/820,466 is subject to patent term adjustment based on the mistake of the Office. 35 USC 154(b)(1)(A)(ii) provides that if the issue of a patent is delayed due to the failure of the Office to respond to a reply under section 132 within 4 months after the date on which the reply was filed, the term of the patent shall be extended 1 day for each day after such period until the Office has responded. As such, Applicants request that the Patent Term Adjustment calculation include this time period.

The Director is invited to call the undersigned at 415.442.1000. The Director is authorized to charge any additional fees that may be required or to credit any overpayment or refunds to Deposit Account No. 50-0310 (Docket No. 067461-5118-US).

Respectfully submitted,

Dated: 10/2/07  
MORGAN, LEWIS & BOCKIUS LLP  
One Market, Spear Street Tower  
San Francisco, CA 94105  
Telephone: 415.442.1000  
Facsimile: 415.442.1001  
Customer No. 67374

  
Robin M. Silva, Reg. No. 38,304

## EXHIBIT A

07/01/2005 12:46 FAX 415 398 3249

DORSEY &amp; WHITNEY LLP-SF

002/002

PTO/SB/1248 (9-05)

Approved for use through 07/01/2006. OMB 0581-0038  
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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Request for  
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To the Commissioner for Patents:

32840

Please record the following data changes to Customer Number:

☒ Please change Address to:

Firm or Individual Name Dorsey &amp; Whitney LLP

Address 505 California Street, Suite 1000

City San Francisco

State CA

Zip 94104-1518

Country USA

Telephone (415) 781-1988

Email

☐ Please delete the following practitioner registration number(s) from the Customer Number indicated above:


☐ Please add the following practitioner registration number(s) from the Customer Number above:


☐ Additional practitioner registration numbers are listed on supplemental sheet(s) attached hereto (PTO/SB/1248 or equivalent)

Request Submitted by: (must be a person, e.g. registered practitioner, associated with the customer number shown above)

Firm Name (if applicable) Dorsey &amp; Whitney LLP

Signature

Name of Person Submitting request Richard F. Thomsen

Telephone Number (415) 781-1988

Registration No.

31,801

Date

July 1, 2005

The submission of information is required by 37 CFR 1.53. The information is required to appear or relate to a benefit by the public which is in the (and by the USPTO to present) an application. Confidentiality is provided by 38 U.S.C. 182 and 37 CFR 1.11 and 1.14. This submission is submitted to have 12 months to complete, including gathering, preparing, and submitting the requested application from the USPTO. This will vary depending upon the individual case. Any comments including gathering, preparing, and submitting the requested application from the USPTO, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND PAGES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop EBC, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing this form, call 1-800-PTO-0198 (1-800-786-0198) and select option.

# EXHIBIT B

## Patent Record Sheet

<b>Docket ID</b>	34100/US/2	<b>Attorneys</b>	SILVA Robin M., NGUYEN Tuan, PARKER AnnEllice, WORRALL Timothy A.	
<b>Former ID</b>		<b>Office</b>	San Francisco	
<b>Client</b>	Xencor, Inc.	<b>Application No</b>	10/820466	
<b>Client-Matter</b>	463077-00272	<b>Application Date</b>	Mar-31-2004	
<b>Client Ref. No</b>	XEN-P005	<b>Grant No</b>		
<b>Country</b>	United States of America	<b>Grant Date</b>		
<b>Short Title</b>	METHODS FOR RATIONAL PEGYLATION OF PROTEINS	<b>1st Publication No</b>	US-2004-0249576-A1	
		<b>1st Publication Date</b>	Dec-09-2004	
		<b>Expiration Date</b>		
		<b>Priority Date</b>		
<b>Inventors</b>	DESJARLAIS John Rudolf, ZALEVSKY Jonathan	<b>License of Right</b>	<input type="checkbox"/> Small Entity	<input type="checkbox"/>
<b>Convention</b>	Pri. Claimed	<b>Claimed Priorities and Parent Records</b>		
<b>Origin</b>		<b>Relation</b>	<b>Docket ID</b>	<b>Application No</b>
<b>Type</b>	Patent	<b>Base Provisional</b>	34100/US	60/459094
<b>Sub Type</b>	Non-provisional application			
<b>Status</b>	Inactive			
<b>Sub Status</b>	Transferred			
		<b>Foreign Assoc. &amp; Ref. No.</b>		
		<b>Tax Receiver</b>		

### Docket

Action / Event Notes	Reminder	Due	Done/Recorded
Check Status on PAIR		Dec-22-2006	
RE-DOCKETED FROM 12/22/2004			
IDS Due		Dec-30-2006	
RE-DOCKETED FROM 6/30/2004			
Priority Claim Due		Jul-31-2004	Jan-01-1850
Application Date			Mar-31-2004
*Notice of Missing Parts Mail Date (See Notes)			Jun-22-2004
Awaiting Filing Receipt		Jun-30-2004	Jun-22-2004
*Notice of Missing Parts - Response Filed			Jul-29-2004
Publ: First			Dec-09-2004

### Memo:

\*\*\*Files have been transferred on 12/12/06 to:  
Robin Silva, Esq.  
Morgan, Lewis & Bockius LLP  
One Market, Spear Street Tower  
San Francisco, CA 94105\*\*\*

## Report Selection

- ☒ by Docket Number  
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Preview before printing ☒

## Report Format

- ☐ Concise  
☒ Comprehensive

## Inventors

- ☐ Print  
☒ Do Not Print

## Remarks

- ☒ Print  
☐ Do Not Print

## Images/Links

- ☐ Print ☒ Do Not Print

## Include Design Countries

- ☐ Print ☒ Do Not Print

## Date Range

- ☒ Filing ☐ Issue ☐ Expiration ☐ Last Update

From: 01-Dec-2006

To: 12-Apr-2007

Docket Number: 67461-5118

Client:

Agent:

Country:

US

United States of America

Area:

Attorney:

Inventor:

Owner:

Location:

Status(es):

Case Type(s):

Status Codes:

- ☐ Active  
☐ Inactive  
☒ All

EXHIBIT C



## EXHIBIT D

### Actions Due

Thursday, September 27, 2007

Page: 1

Docket Number: 67461-5118

SubCase:

Ctry Sub:

Country: US United States of America

Case Type: ORD

Status: Published

Filing Date: 31-Mar-2004

Action Type: PA/RR1

Base Date: 13-Sep-2006

Application #: 10/820,466

Response sent date:

Action(s) Due	Due Date	Indicator	Taken
File Election	13-Oct-2006	Due Date	01-Jan-1850
File Election + 1 Mo. EOT	13-Nov-2006	Due Date	01-Jan-1850
File Election + 2 Mo. EOT	13-Dec-2006	Due Date	01-Jan-1850
File Election + 3 Mo. EOT	13-Jan-2007	Due Date	01-Jan-1850
File Election + 4 Mo. EOT	13-Feb-2007	Due Date	01-Jan-1850
File Election + 5 Mo. EOT	13-Mar-2007	Final	01-Jan-1850

#### Remarks:

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